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10/587,432

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Masahiro Oho

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WENDEROTH, LIND & PONACK L.L.P.

2033 K. STREET, NW

SUITE 800

WASHINGTON, DC 20006

EXAMINER

QAYYUM, ZESHAN

ART UNIT

PAPER NUMBER

3685

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                   |  |
|------------------------------|--------------------------------------|-----------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/587,432 | <b>Applicant(s)</b><br>OHO ET AL. |  |
|                              | <b>Examiner</b><br>ZESHAN QAYYUM     | <b>Art Unit</b><br>3685           |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Claims**

1. Claims 1, 3-25 have been examined.

### **Acknowledgement**

2. Foreign priority (Japan 2004-095646) for this application has been acknowledged.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 3-25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Response to Amendment***

4. Claims 22 and 23 were originally rejected under 112 2nd paragraph because claim was not clear and unsure of whether claim was a method or software. The applicant has amended claims to clearly identify the claim as software. Therefore claims are rejected under 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 21, 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claim 21 recites the limitation "said requesting operation" in line 5. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 22 recites "...the license information *to include* a usage condition ..." in line 4, and "...the usage condition included in the ..." It is unclear to one of the ordinary skill in the art when is the usage condition included in the license information? ( In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 22 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
9. Claims 22 and 23 are directed to a program (i.e. software). It has been held that software without a required computer-readable medium-storing software that, when executed, causes the computer to perform a particular process or method (MPEP 2106.01) is merely nonfunctional descriptive material and non-statutory under 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Wyman (US 5260999) in view of Ginter (US 5892900).

11. With respect to claims 1, 7, 9, 10, 11, 12, 19, 20, 21, 22, 23, 24, 25 Wyman

discloses: a content provider that produces the content, said content provider

including a first fight management device (See Fig 1, Part 28) a service provider that

issues the license information to an end user, said service provider including a

second fight management device (See Fig 1, part 25, and column 10, lines 39-50) a

terminal device for the end user to use the content (See Fig 1, part 16, column 9,

lines 40-42) wherein said second fight management device comprises a license

information generation unit operable to generate the license information to include a

usage condition for allowing usage of the content; and a transmission unit operable

to transmit the generated license information to said terminal device (See column

10, lines 39-50, column 11, lines 15-30 and column 12, lines 14-25);terminal device

comprises: a reception unit operable to receive the license information from said

second right management device (See column 11, lines 15-30 and column 12, lines

14-25)

Wyman does not explicitly discloses: a range designation obtainment unit operable

to obtain edit condition information\_ generated by said first fight management device

that shows a range designation of the usage condition included in the license

information; a usage condition judgment unit operable to judge whether or not the

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usage condition included in the license information received from said second right management device is within the range designated in the obtained edit condition information; and a validation unit operable to validate the received license information only when the usage condition is judged to be within the range, and abandon the received license information when the usage condition is judged not to be within the range. Ginter discloses: a range designation obtainment unit operable to obtain edit condition information\_ generated by said first fight management device that shows a range designation of the usage condition included in the license information; a usage condition judgment unit operable to judge whether or not the usage condition included in the license information received from said second right management device is within the range designated in the obtained edit condition information; and a validation unit operable to validate the received license information only when the usage condition is judged to be within the range, and abandon the received license information when the usage condition is judged not to be within the range. (See column 19, lines 9-58, and column 30, lines 29-40, Fig 79, column 281 lines 23-26). Therefore, it would have been obvious to one of the ordinary skill in to combine Wyman reference with Ginter reference to yield predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

With respect to "operable to ...." (i.e. capable of being used or desirable to use) it is intended use of the units above. Therefore it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an

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apparatus must be distinguished from the prior art in terms of structure rather than function alone-MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

In addition with respect to "when clause", according to MPEP "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. (MPEP 2106 II C)" therefore the language "when" will not distinct the claims from prior art.

12. With respect to claims 3, 8 Wyman in view of Ginter discloses all the limitations as described above. Ginter further discloses: wherein said second right management device is further comprises: a second range designation obtainment unit; a second usage condition judgment unit; and a second validation unit, wherein said second range designation obtainment unit is operable to obtain the edit condition information generated by said first right management device that shows the range designation of the usage condition, said second usage condition judgment unit is operable to judge whether or not the usage condition is within the range designated in the edit condition information, and said second validation unit is operable to insert a content key, which key is for decrypting encrypted content, into the generated license information only when the usage condition is within the range (See column 19, lines 9-58, column 30, lines 29-40, Fig 79, column 156 lines 1-10 and column 281, lines 23-26).

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With respect to "operable to ...." (i.e. capable of being used or desirable to use) it is intended use of the units above. Therefore it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone-MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

In addition with respect to "when clause", according to MPEP "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. (MPEP 2106 II C)" therefore the language "when" will not distinct the claims from prior art.

13. With respect to claims 4, 5, and 6, 13, 14, 15, 16, 17, 18 Wyman in view of Ginter discloses all the limitations as described above. Ginter further discloses: said first right management device comprises a contract license (i.e. PERC) generation unit operable to generate contract license information including the content key and the edit condition information and, a transmission unit operable to transmit the generated contract license to said second right management device; and said second right management device further comprises a contract license reception unit operable to receive the contract license from said first fight management device; said second range designation obtainment unit is operable to obtain the edit condition information from the received contract license; said second usage



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condition judgment unit is operable to judge whether or not the usage condition included in the generated license information is within the range shown in the obtained edit condition information; and said second validation unit is operable to extract the content key from the received contract license and to insert the extracted content key into the generated license information only when the usage condition is within the range. See column 19, lines 9-58, column 30, lines 29-40, Fig 79, column 155, lines 38-67, column 156 lines 1-10, and column 281, lines 23-26 ).

With respect to "operable to ...." (i.e. capable of being used or desirable to use) it is intended use of the units above. Therefore it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone-MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

In addition with respect to "when clause", according to MPEP "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. (MPEP 2106 II C)" therefore the language "when" will not distinct the claims from prior art.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Z. Q./

Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685